



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/054,749	01/18/2002	David G. Stork	015358-006710US	4058

20350 7590 12/12/2006

TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

BHATIA, AJAY M

ART UNIT	PAPER NUMBER
----------	--------------

2145

DATE MAILED: 12/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/054,749

Applicant(s)

STORK ET AL.

Examiner

Ajay M. Bhatia

Art Unit

2145

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-68 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-68 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 7/27/06
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Response to Arguments

Applicant's arguments with respect to claims 1-68 have been considered but are moot in view of the new ground(s) of rejection. Applicant has filed an RCE 10/26/2006.

Allowable Subject Matter

Claim 68 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-22, 67 and 68 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Presently the claim discloses method steps, but at no point do claim disclose any limitations that include any hardware, therefore claim discloses are software which are not on an apparatus or media therefore not patentable.

Claims 45-66 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Disclose apparatus claims but not apparatus is defined. i.e. a server computer or hardware system running the present process.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-67 are rejected under 35 U.S.C. 102(b) as being anticipated by Caruso et al. (U.S. Patent N. 5,848,271).

For claim 1, Caruso teaches, a method of processing a document in a workflow system, the method comprising: (Caruso, Col. 9 lines 63-67, flow)

detecting when a document is at a place in a first workflow network that allows attachment of workflow networks associated with the document to the place of the first workflow network, the first workflow network specifying a plurality of operations to be performed on the document including a first operation and a second operation, the place occurring at a location in the first workflow network after the first operation and before the second operation is performed on the document; (Caruso, Col. 11 lines 7-20, trigger)

determining, when the document is at the place that allows attachment of workflow networks associated with the document, if a second workflow network specified by the document is permitted to be attached to the place of the first workflow network, the second workflow network specifying one or more operations to be performed on the document; (Caruso, Col. 11 lines 45-55, to do list)

and if the second workflow network specified by the document is permitted to be attached to the place of the first workflow network, attaching the second workflow network to the place of the first workflow network such that the document is processed according to the second workflow network before returning, upon completion of processing of the document according to the second workflow, to the place of the first workflow network to continue processing of the document according to the first workflow network before the second operation specified by the first workflow network is performed on the document. (Caruso, Col. 11 lines 7-20, add, Col. 12 lines 47-55, create process)

For claim 2, Caruso teaches, the method of claim 1 wherein the first workflow network is configured by a workflow designer and the second workflow network is configured by an author of the document. (Caruso, Col. 10 lines 31-35, your activities)

For claim 3, Caruso teaches, the method of claim 1 wherein detecting when the document is at the place in the first workflow network comprises:

detecting when the first operation has been performed on the document.
(Caruso, Col. 11 lines 7-20, trigger)

For claim 4, Caruso teaches, the method of claim 1 wherein determining if the second workflow network specified by the document is permitted to be attached to the place of the first workflow network comprises:

determining permissions information specified for the place; (Caruso, Col. 10 lines 31-35, security database)

and determining that the second workflow network specified by the document is permitted to be attached to the place of the first workflow if the document satisfies the permissions information specified for the place. (Caruso, Col. 12 lines 47-55, create process)

For claim 5, Caruso teaches, the method of claim 4 wherein the permissions information specified for the place is configured by a designer of the first workflow network. (Caruso, Col. 10 lines 37-43, Col. 12 lines 47-55, your activities)

For claim 6, Caruso teaches, the method of claim 1 wherein determining if the second workflow network specified by the document is permitted to be attached to the place of the first workflow network comprises:

determining permissions information associated with the document; (Caruso, Col. 10 lines 31-35, security database)

and determining that the second workflow network specified by the document is permitted to be attached to the place of the first workflow if the permissions information associated with the document permits the attachment. (Caruso, Col. 12 lines 47-55, activity list)

For claim 7, Caruso teaches, the method of claim 6 wherein the permissions information associated with the document is configured by an author of the document. (Caruso, Col. 10 lines 31-35, security database)

For claim 8, Caruso teaches, the method of claim 1 wherein attaching the second workflow network to the place of the first workflow network such that the document is processed according to the second workflow network before the second operation specified by the first workflow network is performed on the document comprises:

performing at least one operation from the one or more operations specified by the second workflow network on the document before performing the second operation specified by the first workflow network on the document. (Caruso, Col. 11 line 55 to Col. 12 line 11, to do list)

For claim 9, Caruso teaches, the method of claim 1 wherein attaching the second workflow network to the place of the first workflow network such that the document is processed according to the second workflow network before the second operation specified by the first workflow network is performed on the document comprises:

identifying a set of one or more workflow networks specified by the document;
(Caruso, Col. 10 lines 9-20, activity lists)

identifying a workflow network from the set of workflow networks that satisfies a selection criterion; (Caruso, Col. 9 lines 63-67, flow)

and processing the second document according to the workflow network identified from the set of workflow networks before performing the second operation specified by the first workflow network on the document. (Caruso, Col. 10 lines 60-67, completed activity)

For claim 10, Caruso teaches, the method of claim 1 wherein the second workflow network attached to the place of the first workflow network comprises a place of the second workflow network that allows attachment of workflow networks associated with the document at the place of the second workflow network. (Caruso, Col. 12 lines 47-55, new process)

For claim 11, Caruso teaches, the method of claim 1 further comprising:

if the second workflow network specified by the document is not permitted to be attached to the place of the first workflow network:

determining a set of workflow networks attached to the place of the first workflow network; (Caruso, Col. 10 lines 47-55, activities)

identifying at least one workflow network from the set of workflow networks for processing the document; (Caruso, Col. 12 lines 10-12, calls registration)

and processing the document according to the at least one workflow network before performing the second operation specified by the first workflow network on the document. (Caruso, Col. 12 lines 47-57, new process)

For claim 12, Caruso teaches, the method of claim 1 further comprising:

if the second workflow network specified by the document is not permitted to be attached to the place of the first workflow network:

determining a first set of workflow networks attached to the place of the first workflow network; (Caruso, Col. 12 lines 47-57, activities)

based upon permissions information associated with the document, detaching one or more workflow networks included in the first set of workflow networks from the place such that a second set of workflow networks remain attached to the place; (Caruso, Col. 12 lines 47-57, activities)

identifying at least one workflow network from the second set of workflow networks for processing the document; (Caruso, Col. 12 lines 47-57, activities)

and processing the document according to the at least one workflow network before performing the second operation specified by the first workflow network on the document. (Caruso, Col. 11 lines 60-67, completed)

Claims 13-67 list all the same elements of claims 1-12. Therefore, the supporting rationale of the rejection to claims 1-12 applies equally as well to claims 13-67.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See attached Notice of references cited (if appropriate).

Art Unit: 2145

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ajay M. Bhatia whose telephone number is (571)-272-3906. The examiner can normally be reached on M-F 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on (571)272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



AB



Jason Cardone
Supervisor Patent Examiner
Art Unit 2145